

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Heroux et al.
Title: ASSAYS FOR MEASURING NUCLEIC ACID BINDING
PROTEINS AND ENZYME ACTIVITIES
Appl. No.: 09/976,437
Filing Date: 10/15/2001
Patent No.: 7,439,017
Grant Date: 10/21/2008
Examiner: Chunduru, Suryaprabha
Art Unit: 1637
Confirmation No.: 3932

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705

The Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 10/21/2008 as U.S. Patent No. 7,439,017.

The Patent Office determined that the patent was entitled to 261 days of PTA. The Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 C.F.R. § 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. § 154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

The Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 573 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 C.F.R. §§ 1.702(a) and (b), and under 37 C.F.R. §§ 1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	829 days
(b) Total Applicant delay:	256 days
Final PTA Determination:	573 days

The Applicants therefore respectfully request that the patent be accorded 573 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is being paid by credit card via EFS-Web. The Commissioner is hereby authorized to charge any additional fees which may be required regarding this submission under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 10-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

Date Dec. 10, 2008

By 

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Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 090900-0156

Application Number: 09/976437

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	10/15/2001	0		
	14 month From Application date	12/15/2002	426		
Edit Delete	Restriction Requirement	10/02/2003	717	291	
Edit Delete	Restriction Requirement Response Received at PTO	11/03/2003	749		
Edit Delete	Restriction Requirement	02/24/2004	862		
Edit Delete	Restriction Requirement Response Received at PTO	05/24/2004	952		
	Restriction Requirement Response Filed + 4 months	09/24/2004	1,075		
	3 Year Period Starts	10/15/2004	1,096		
Edit Delete	Non-Final Office Action	10/19/2004	1,100		
	Non-Final Office Action + 3 months	01/19/2005	1,192		
Edit Delete	Non-Final Office Action Response Received at PTO	04/18/2005	1,281		89
Edit Delete	Final Office Action	07/08/2005	1,362		
	Final Office Action + 3 months	10/08/2005	1,454		
Edit Delete	Request For Continued Examination	12/07/2005	1,514		60
	3 Year Period Stopped	12/07/2005	1,514	439	
Edit Delete	Non-Final Office Action	02/23/2006	1,592		
	Non-Final Office Action + 3 months	05/23/2006	1,681		
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Edit Delete	Final Office Action	09/15/2006	1,796		
Edit Delete	Final Office Action Response Received at PTO	12/14/2006	1,886		
Edit Delete	Final Office Action	01/12/2007	1,915		
	Final Office Action + 3 months	04/12/2007	2,005		
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Edit Delete	Advisory Action	05/23/2007	2,046		
Edit Delete	Request For Continued Examination	06/15/2007	2,069		64
Edit Delete	Non-Final Office Action	08/07/2007	2,122		
	Non-Final Office Action + 3 months	11/07/2007	2,214		
Edit Delete	Non-Final Office Action Response Received at PTO	11/29/2007	2,236		22
Edit Delete	Notice of Allowance	01/18/2008	2,286		
Edit Delete	Issue Fee Paid	03/14/2008	2,342		
	Issue Fee Paid + 4 months	07/14/2008	2,464		
Edit Delete	Patent Grant Date	10/21/2008	2,563	99	
			Totals:	829	256
			PTA:	573	



Version: 3.01.09

LOGIN: Deb Kocorowski

IP: 10.50.33.83

Foley & Lardner LLP